

REMARKS

We have canceled all of the previously pending claims and replaced them with claims 34-53, which include claims 34 and 50 as the independent claims. Each of the independent claims recites a surgical apparatus that includes at least the following features: i) a first member having a portion configured for attachment to the patient and a first coupling disposed proximate the portion configured for attachment; ii) the first member defining a passageway for accessing the body cavity through the incision; iii) a second member including a second coupling configured for releasable attachment to the first coupling; and iv) the second member further including a flexible portion configured to extend into the passageway and surround a surgeon's arm passing through the passageway.

The action rejected some of the previously pending claims as anticipated by each of Cuschieri (U.S. Patent 5,480,410), Golub (U.S. Patent 5,514,133), and Charowsky (U.S. Patent 4,998,538). We submit that the features recited in the new claims distinguish each of these prior art patents. For example, we can find no teaching in any of these prior art patents of a second member including a flexible portion configured to extend into a passageway defined by a first member and surround a surgeon's arm passing through the passageway, wherein the first and second members also include couplings configured for releasable attachment.

The action also rejected the previously pending claims for obviousness-type double patenting in view claims 1-29 of U.S. Patent No. 5,653,705. We submit that the double patenting rejection may not be applicable to the new set of claims. In any case, we ask that the Examiner allow us to defer the decision as to whether to file a terminal disclaimer to obviate the double patenting rejection until he indicates that the present claims are otherwise allowable.

Applicant : Roger A. de la Torre et al.  
Serial No. : 10/004,468  
Filed : October 23, 2001  
Page : 7

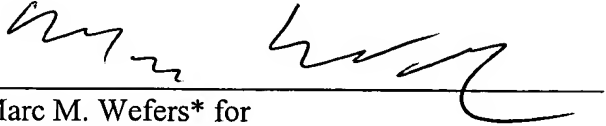
Attorney's Docket No.: 00167-293004 / 02-31-0384

Applicant asks that all claims be allowed. Enclosed is a \$400 check for the Petition for Extension of Time fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: \_\_\_\_\_

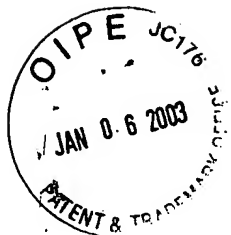
10/21/02



Marc M. Wefers\* for  
Peter J. Devlin  
Reg. No. 31,753

Fish & Richardson P.C.  
225 Franklin Street  
Boston, Massachusetts 02110-2804  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906

**\*See attached document certifying that Marc M. Wefers has limited recognition to practice before the U.S. Patent and Trademark Office under 37 C.F.R. §10.9(b).**



BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE  
UNITED STATE PATENT AND TRADEMARK OFFICE

LIMITED RECOGNITION UNDER 37 CFR § 10.9(b)

Marc M. Wefers is hereby given limited recognition under 37 CFR §10.9(b) as an employee of Fish & Richardson P.C., to prepare and prosecute patent applications wherein the patent applicant is the client of Fish & Richardson P.C. and the attorney or agent of record in the applications is a registered practitioner who is a member of Fish & Richardson P.C. This limited recognition shall expire on the date appearing below, or when whichever of the following events first occurs prior to the date appearing below: (i) Marc M. Wefers ceases to lawfully reside in the United States, (ii) Marc M. Wefers' employment with Fish & Richardson P.C. ceases or is terminated, or (iii) Marc M. Wefers ceases to remain or reside in the United States on an H-1B visa.

This document constitutes proof of such recognition. The original of this document is on file in the Office of Enrollment and Discipline of the U.S. Patent and Trademark Office.

Expires: January 7, 2003

Harry I. Moatz  
Director of Enrollment and Discipline

RECEIVED  
JAN 08 2003  
TECHNOLOGY CENTER R3700